

**REMARKS**

This Amendment is submitted in response to the Office Action mailed May 17, 2005. Claims 1-13 remain pending in the application and claims 12 and 13 are allowed. Claims 1-3 and 6-11 stand rejected and claims 4 and 5 were objected to for depending from rejected base claims. Applicants respectfully traverse the rejections of claims 1-3 and 6-11 for the reasons set forth below, and respectfully request reconsideration in view of the following remarks.

**Clarification of Rejections under 35 U.S.C. §112**

As an initial matter, Applicants note that the Office Action mailed May 17, 2005, at page 9, item 11(b), refers to the rejections of claims 1-13 under 35 U.S.C. §112, first paragraph, indicating that the amendment filed January 26, 2005, was deemed unpersuasive. Applicants note, however, that the Detailed Action maintains no rejection of claims 1-13 under 35 U.S.C. §112, first paragraph. Accordingly, Applicants presume that this reference to rejections under 35 U.S.C. §112, first paragraph, is a typographical error. If this presumption is incorrect, Applicants respectfully request that such rejections be detailed in the next communication from the Office.

**Objections to the Specification**

Paragraph 37 of the specification was objected to for a typographical error in line 1. This error has been corrected as suggested by the Examiner. Accordingly, Applicants respectfully request that the objection to the specification be withdrawn.

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**Claims Rejected Under 35 U.S.C. §103**

Claims 1 and 8-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,865,438 to Wada in view of U.S. Patent No. 4,833,890 to Kelman. Claims 1 and 10 are the only independent claims of this rejected group. Claim 1 is directed to a magnification loupe having an objective lens with a non-circular shape, "wherein at least two oppositely disposed arcuate first peripheral edges are defined by a first radius and wherein at least two oppositely disposed arcuate second peripheral edges are defined by at least one second radius." Claim 10 is directed to a magnification viewer comprising a magnification loupe as recited in claim 1. The claimed non-circular shape of the lens elements helps to minimize the weight of the optical loupes by reducing the overall size of the lens, while not adversely effecting the field of view, as set forth in the application at page 4, paragraph 10, and page 12, paragraph 37. Accordingly, the claimed non-circular shape of the lens elements provides benefits not appreciated by the references of record.

The Examiner admits that Wada '438 does not teach or suggest "the arcuate shape of the peripheral surfaces of the objective lens element," (Office Action mailed May 17, 2005, at page 4). The Examiner alleges, however, that it would have been obvious to modify the lens of Wada '438 to have arcuate upper and lower edges in view of Kelman '890, "for the purpose of reducing the effects of flare/harmful light to the optical quality of the viewer." (May 17 Office Action at page 5.) Applicants respectfully traverse. To establish a *prima facie* case of obviousness, the Examiner must show "some objective teaching in the prior art or that knowledge generally

available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 5 USPQ.2d 1596, 1598 (Fed. Cir. 1988). In this case, Kelman '890 does not teach or suggest that a curved edge reduces the effects of flare or harmful light incident on a lens. Rather, Kelman '890 utilizes opaque wings 15, separate from the intraocular lens disclosed therein, to "define light-masking means 16" for that device. (Kelman '890 at column 5, lines 1-8.) The Examiner therefore has not cited any reference which supports this alleged motivation to modify the lens of Wada '438, and Applicants therefore seasonably traverse the basis for this rejection.

Moreover, Applicants assert that Kelman '890 provides no motivation to modify the lens of Wada '438 because Kelman '890 is directed to an intraocular lens which is intended to be implanted in the human eye. The lens has a generally oblong, rectangular or oval/elliptical shape so that the lens may be inserted through a minimum width incision made in a patient's eye. In contrast, the optical loupes of the present invention are intended to be mounted to a user wearable device, such as pair of spectacles, and worn externally of a person's eye. The claimed optical loupes do not contain lenses that are inserted within a patient's eye. Accordingly, while Kelman '890 depicts intraocular lens elements having straight and curved edges, there is no teaching or suggestion to apply features of that intraocular lens to an optical loupe, nor any motivation to modify the optical loupes of Wada '438 as alleged by the Examiner. For at least these reasons, Applicants respectfully request that the rejections of claims 1 and 10 over Wada '438 in view of Kelman '890 be withdrawn.

Claims 8 and 9 each depend from independent claim 1, and are therefore in condition for allowance for at least the reasons stated above for claim 1.

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Accordingly, Applicants respectfully request that the rejections of claims 8 and 9 over Wada '438 in view of Kelman '890 be withdrawn.

Claims 1-3, 6, 8 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,273,456 to Feinbloom in view of Kelman '890.

Claims 1 and 10 are the only independent claims in this rejected group, and are directed to a magnification loupe and a magnification viewer, respectively, as discussed above. The Examiner admits that Feinbloom '456 does not teach "at least two oppositely disposed arcuate second peripheral edges," as recited in claims 1 and 10. (See May 17 Office Action at page 6.) The Examiner asserts, however, that it would have been obvious to modify the lens of Feinbloom '456 in view of Kelman '890 "for the purpose of reducing flare/harmful light to the optical quality of the viewer." (May 17 Office Action at page 8.) Again, Applicants note that this alleged motivation of reducing flare/harmful light is not taught or suggested by Kelman '890, and the Examiner has not cited any reference which supports this alleged motivation to modify the lenses of Feinbloom '456. Nor has the Examiner provided any evidence that such motivation is well known in the art. To the contrary, Applicants assert that the particular shape of the edges of the lens has no bearing on the "effects of flare/harmful light to the optical quality of the viewer," as asserted by the Examiner. In particular, Applicants note that the lenses of optical loupes are generally supported at their outer edges by loupe housings, thereby preventing light from entering the lenses at the edges. When lens edges are exposed, conventional practice is to "frost" or roughen the edges, thereby preventing light from entering at the edges. For these reasons, Applicants assert that

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there is no motivation to modify the lenses of, Feinbloom '456 as alleged by the Examiner.

Applicants further assert that Kelman '890 does not provide motivation to modify the lens of Feinbloom '456, as alleged by the Examiner, because Kelman '890 is directed to an intraocular lens that is intended to be implanted into a human eye. The lenses disclosed in Kelman '890 have generally oblong, rectangular or oval/elliptical shapes so that the lens may be inserted through a minimum width incision made in a patient's eye. The lenses of the claimed optical loupes are not inserted within a patient's eye, and there is no teaching or suggestion in Kelman '890 that the particular intraocular lens configurations disclosed therein for implantation in a human eye are applicable to lenses of optical loupes which are entirely different from intraocular lenses. For at least the reasons set forth above, Applicants respectfully request that the rejections of claims 1 and 10 over Feinbloom '456 in view of Kelman '890 be withdrawn.

Claims 2, 3, 6 and 8 each depend from independent claim 1 and are therefore in condition for allowance for at least the reasons stated above for claim 1. Accordingly, Applicants respectfully request that the rejections of claims 2, 3, 6 and 8 over Feinbloom '456 in view of Kelman '890 be withdrawn.

Claims 7 and 11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Feinbloom '456 and Kelman '890 in further view of U.S. Patent No. 6,061,189 to Caplan et al. Claim 7 depends from independent claim 1, and claim 11 depends from independent claim 10. Accordingly, claims 7 and 11 include each and

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every element recited in claims 1 and 10, respectively, from which they depend.

Applicants respectfully traverse the rejections of claims 7 and 11 because the combination of Feinbloom '456 and Kelman '890 does not teach or suggest each and every element of claims 7 and 11, as discussed above with respect to the rejections of claims 1 and 10. The combination of Feinbloom '456 and Kelman '890 with Caplan '189 does not cure these deficiencies. Specifically, Kelman '890 provides no motivation for modifying the lens of Feinbloom '456 to have "oppositely disposed arcuate second peripheral edges," as required by the claims and discussed above with respect to claims 1 and 10. Caplan '189 is directed to a binocular viewer having circular objective lenses and there is no teaching or suggestion in Caplan '189 to modify the lens of Feinbloom '456 to have arcuate peripheral edges. For at least these reasons, Applicants respectfully request that the rejections of claims 7 and 11 over the combination of Feinbloom '456, Kelman '890 and Caplan '189 be withdrawn.

#### Secondary Indicia of Non-obviousness

As further evidence of the non-obviousness of the claimed invention, Applicants note the secondary evidence of non-obviousness set forth in the declaration of Brian Wilt, filed on even date herewith. Specifically, Applicants note that optical loupes according to the invention have enjoyed commercial success since their introduction, and have been the impetus behind sales volumes displaced from conventional optical loupes and sales volumes taken from competitors. This commercial success is attributable to the inventive features recited in the pending

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claims, as set forth in the declaration of Brian Wilt.

Moreover, Applicants note that the primary reference of Wada '438 and the secondary reference of Kelman '890 are both approximately 16 years old, and the primary reference of Feinblom '456 is nearly 40 years old. The fact that persons skilled in the art have not implemented the claimed invention during this time, is further evidence of the non-obviousness of the claimed invention.

In view of the foregoing amendments to the claims and remarks given herein, Applicants respectfully believe this case is in condition for allowance and respectfully request allowance of the pending claims. If the Examiner believes any matter requires further discussion, the Examiner is respectfully asked to telephone the undersigned attorney so that the matter may be promptly resolved. The Examiner's prompt attention to this matter is appreciated.

Applicants are of the opinion that a fee of \$120.00 is due for one month's extension of time as a result of this amendment. If any additional charges or credits are necessary to complete this communication, please apply them to Deposit Account No. 23-3000.

Respectfully submitted,

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